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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/934,841

08/23/2001

Dennis Thomas Gilham

5058

5479

26936 7590 02/26/2008
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EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

02/26/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/934,841
Filing Date: August 23, 2001
Appellant(s): GILHAM, DENNIS THOMAS

Charles W. Fallow, Reg. No. 28,946
Shoemaker & Mattare, Ltd.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 26, 2007 appealing from the Final Office action mailed November 3, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 11-13 appears on page 6 of the Appendix to the appellant's brief. The minor errors are as follows: canceled claims 1-10 are not listed as canceled in the Appendix.

(8) Evidence Relied Upon

6,249,777	KARA et al	06-2001
5,671,146	WINDEL et al	09-1997
4,998,204	SANSONE et al	03-1991
5,799,086	SUDIA	08-1998
6,424,954	LEON	07-2002
6,587,843	GELFER et al	07-2005
6,889,214	PAGEL et al	05-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al (US 6,249,777), in view of Windel et al (US 5,671,146).

Regarding claim 11 –

Kara discloses a method of printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including the steps of storing a secret key; determining a period of time in which postal indicia are to be printed on a

Art Unit: 3600

plurality of mail items (fig 2, see user password); storing a postage value relating to postage charges dispensed in said period of time (see, e.g. fig 3, 304); providing postage data including said postage value (see, e.g. fig 3, 305); generating a key relating specifically to a mail item by utilizing said secret key and said postage data; generating an authentication code by utilizing said key and said postage data; and printing said postage data and said authentication code as a postal indicium on said mail item (e.g. col 4 ln 5-40).

Kara does not, however, disclose a modified key or generating a modified key or modifying a key, in the context of postal security. Windel, however, does, at, e.g., column 19, ln 1-5. It would be obvious to one of ordinary skill in the art to combine the teachings of Kara and Windel in order to obtain greater security and greater fraud prevention in mail processing.

Regarding claim 12 –

Kara discloses a postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including: clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items (e.g. col 8 ln 2-15, any array of memories); a register for storing a postage value relating to postage charges dispensed in said period of time; memory means for storing a secret key; electronic control means; and input means operable to input item data relating to a mail item to said electronic control means; wherein said electronic control means is configured to generate a key relating specifically to said mail item by utilizing said secret key and postage data including said

item data and said postage value, and generate an authentication code by utilizing said key and said postage data (e.g. col 4 ln 5-40; e.g. col 8 ln 2-15, any array of memories).

As above, Kara does not, however, disclose a modified key or generating a modified key or modifying a key, in the context of postal security. Windel, however, does, at, e.g., column 19, ln 1-5. It would be obvious to one of ordinary skill in the art to combine the teachings of Kara and Windel in order to obtain greater security and greater fraud prevention in mail processing.

(10) Response to Argument

First Issue

Appellant argues, regarding claims 11-13, that, as “noted by Examiner”, Kara “makes no disclosure or suggestion of a method or apparatus which utilizes a modified key in the manner as required by the claimed invention.”

Examiner respectfully disagrees and directs attention to the Final Rejection, paper number 20061030, paragraph 8, which states “Kara does not, however, disclose a modified key or generating a modified key or modifying a key . . . “

The same Final Rejection states, in paragraph 7, that Kara does disclose “generating a key relating specifically to a mail item by utilizing said secret key and said postage data; generating an authentication code by utilizing said key and said postage data; and printing said postage data and said authentication code as a postal indicium on said mail item (e.g. col 4 ln 5-40)”. In other words, it is only the modifying of the key that

Kara does not disclose, while the unmodified key disclosed in Kara is, in fact, utilized as required by the claimed invention.

Further, Windel does disclose modifying a key in the context of postal security. (e.g. col 19, ln1-5), and it is for this proposition only that Windel is included and combined with Kara.

Also, numerous other references disclose modifying a key in the context of postal security. Examiner has made reference, to Sudia (US 5,799,086) which discloses an enhanced cryptographic system and method with key escrow feature, including key modification, and Gelfer et al (US 6,587,843) disclose a method for improving the security of postage meter machines in the transfer of credit, including key modification.

Given the abundance of key modification in the literature, both in and out of the context of *postal* security, key modification is certainly old and well-known. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kara and Windel in order to obtain greater security and greater fraud prevention in mail processing. Further, keys may be modified based on any obvious information, including postage value, related to postage charges. Motivation for this is having the proper person or entity paid whatever money is due to them. Thus, the claims merely recite combination which only unite old elements with no change in their respective functions and which yield predictable results. Also, *KSR* forecloses the argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 83 USPQ2d at 1396.

As stated by Appellant, (t)" The fact that key modification per se is known from the prior art . . . certainly does render obvious the claimed invention." (Appellant's Brief, page 5, first full paragraph).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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APPENDIX

09/934,841 – Claim 11 and Kara (US 6,249,146) and Windel (US 5,671,146)

Clause No.	Claim 11	Kara (US 6,249,146)
1	<p>Secret key</p> <p>A method of printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including the steps of:</p> <p>storing a secret key;</p>	<p>User password</p> <p>Fig 2</p>
2	<p>Period of time</p> <p>determining a period of time in which postal indicia are to be printed on a plurality of mail items;</p>	<p>Is demand "valid"</p> <p>304</p> <p>Fig 3</p>
3	<p>Postage value stored</p> <p>storing a postage value relating to postage charges dispensed in said period of time;</p>	<p>"valid funding" 305 Fig 3</p>

Clause No.	Claim 11	Kara (US 6,249,146)
4	providing postage data including said postage value;	Fig 3, 305

5	key generating a key relating specifically to a mail item by utilizing said secret key and said postage data;	Indicia with encrypted information (col 4 ln 5-40)
6	generating an authentication code by utilizing said key and said postage data; and	It shall be understood that as an alternative, or in addition, to the use of encryption in the transmission of the data packet, a system wherein the transmitted data packet only contains information sufficient to enable the forming of a portion of the desired postage indicia may be used if desired. (col 13 ln 10-30)
7	printing said postage data and said authentication code as a postal indicium on said mail item.	"printed on an item of mail" Col 4 ln 493 ln 35-60
8	Modified key	e.g. Windel at col 19 ln 1-5